

R E M A R K S

Claims 1, 8, and 9 are amended. Claims 3 and 18 are canceled. New claims 21-29 are added. Claims 2, 4-7, 10-17, 19, and 20 stand as originally filed. Re-examination and reconsideration are requested.

In the office action, paper number 2, dated September 9, 2003, the examiner provisionally rejected claims 1, 9, 18, and 19 under the judicially-created doctrine of double patenting over claims 1, 10, 19, and 20 of co-pending application serial no. 09/696,719. The examiner rejected claims 1, 2, 4-7, 9-15, and 18-20 under 35 U.S.C. §103(a) as being unpatentable over Kawai, et. al., U.S. Patent No. 6,043,866 (Kawai). The examiner objected to claims 3 and 8 as being dependent on a rejected base claim, but indicated they would be allowable if rewritten to include the limitations of the base claim and any intervening claims. The examiner allowed claims 16 and 17.

Re the Claims:

Claim 1 is amended to include the subject matter previously contained in claim 3 (now canceled). Claim 1, and the claims depending therefrom (i.e., claims 2, 4-7, and 9-15) should now be allowable.

Claim 8 is amended to place it in independent form and to include the limitations of the base claim from which it depended, i.e., claim 1, and intervening claim 7. Claim 8 should now be allowable.

Claim 9 is amended to more clearly define the subject matter.

Re the Double Patenting Rejections:

The examiner provisionally rejected claims 1, 9, 18, and 19 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10, 19, and 20 of co-pending application serial no. 09/696,719.

Because the claims of co-pending application serial no.

09/696,719 have been amended since the time the examiner issued the current double patenting rejections, and because the current double-patenting rejections are provisional in nature, applicant will address the merits of the current double patenting rejection once it is non-provisional in nature.

Re the Rejections of the Claims:

The examiner rejected claims 1, 2, 4-7, 9-15, and 18-20 as being obvious over the Kawai reference. However, in light of the amendments to claim 1, and the cancellation of claim 18, these rejections are now moot as to claims 1, 2, 4-7, and 9-15. Therefore, the rejections of these claims will not be discussed in further detail.

Independent claim 19 is allowable in that the Kawai reference fails to teach or suggest a method for making a greeting card that meets the limitations of claim 19. Therefore, Kawai cannot be used to establish a prima-facie case of obviousness of claim 19.

The Kawai reference describes a carrier sheet for allowing thick, undersized originals to be fed through pinch rollers of document feeding systems. Specifically, the Kawai invention addresses problems associated with the "deviation" (i.e., unwanted movement) of the original, top, and bottom sheets as they are carried through the pinch rollers. Kawai devotes a significant portion of the disclosure to a description of these problems, as well as how the carrier sheet solves the problems. See, for example, Kawai at col. 1, line 64 through col. 2, line 61; col 4, lines 37-51; col. 5, lines 44-56; col. 6, lines 27-39; col. 7, lines 3-18; and col. 9, lines 22-38. Kawai solves these problems by providing the carrier sheet with "original nipping means," which prevent the shifting of the original as well as the upper and lower sheets. See, for example, col. 2, lines 4-61, and claims 1, 5, and 6, of Kawai.

Applicant notes that it is well-established patent law that when obviousness is based on a single prior art reference, there

must be a showing of a suggestion or motivation to modify the teachings of that reference. In re Kotzab, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). Moreover, the hypothetical "person having ordinary skill in the art" is a person that thinks along the lines of conventional wisdom and is not one who undertakes to innovate, whether by extraordinary insights or by patient and often expensive systematic research. Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 227 USPQ 293 (Fed. Cir. 1985).

Because the Kawai reference discloses nothing about greeting cards, much less any methods for making greeting cards, Kawai cannot be said to provide the suggestion or motivation required to modify the teachings of Kawai to make obvious the method of claim 19.

Dependent claim 20 is at least allowable in that it depends from claim 19, which is allowable.

Re New Claims 21-29:

New claims 21-29 are believed to be allowable in that Kawai fails to disclose or suggest apparatus containing the elements and limitations of the new claims. That is, because the Kawai reference is directed to problems associated with feeding thick, undersized original through the pinch rollers of document feeding systems, as discussed above, Kawai cannot be said to provide the suggestion or motivation required to modify the Kawai reference in the manner required by new claims 21-29. Therefore, new claims 21-29 are *prima-facie* allowable over Kawai.

Applicant believes that all of the claims pending in this patent application are allowable and that all other issues raised by the examiner have been rectified. Therefore, applicant respectfully requests the examiner to reconsider the rejections and to grant an early allowance. If any questions or issues remain to be resolved, the examiner is requested to contact the

applicant's attorney at the telephone number listed below.

Respectfully submitted,

DAHL & OSTERLOTH, L.L.P.

A handwritten signature in dark ink, appearing to read "Bruce E. Dahl", is written over a horizontal line.

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